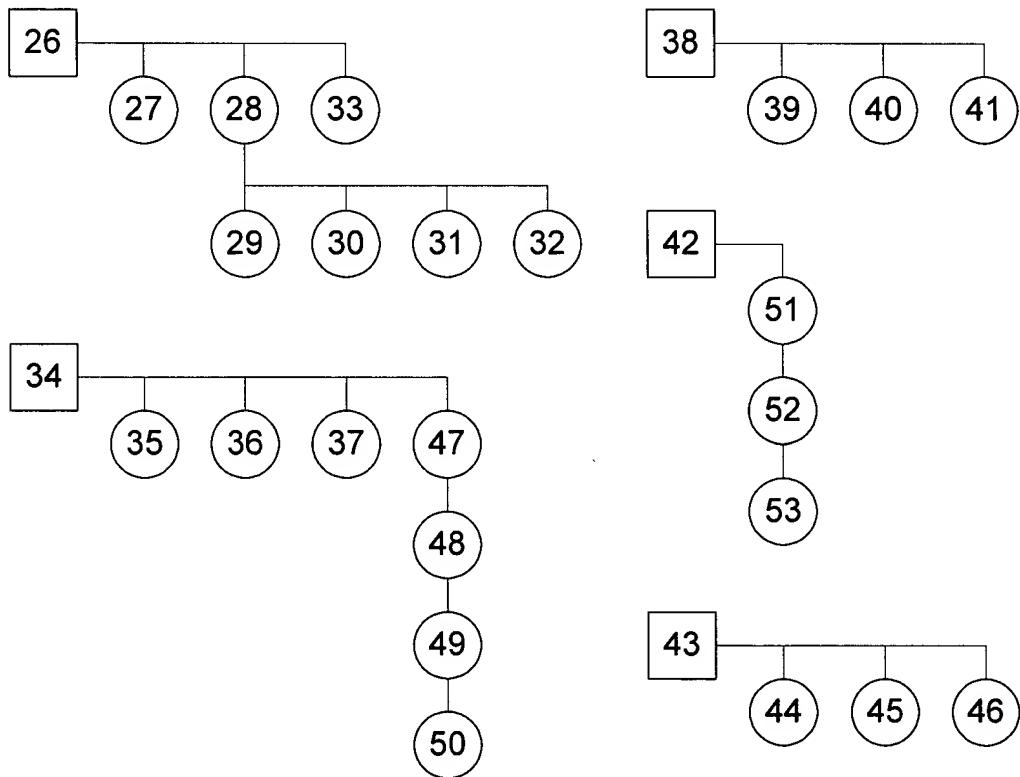


REMARKS

Reconsideration of the application is respectfully requested. An Office action mailed November 5, 2004 is pending in the application. Applicants have carefully considered the Office action and the references of record. In the Office action, claims 34-37 and 42-46 were rejected under 35 U.S.C. § 102, and claims 26-33 and 38-41 were rejected under 35 U.S.C. § 103. In this response to the Office action, claims 26, 34, 38 and 42-43 have been amended, and claims 47-53 have been added. Therefore, claims 26-53 are pending in the application. The following diagram depicts the relationship between the independent and dependent claims.



Rejections Under 35 U.S.C. § 102 of the Independent Claims

Each of the independent claims 34 and 42-43 stands rejected under 35 U.S.C. § 102(b) as being anticipated by “Adobe® FrameMaker®+SGML 5.5: Developing SGML Publishing Applications,” 1997 (hereinafter *AFM97*) and C.F. Goldfarb and P. Prescod, “The XML Handbook™,” 1998, pp. 278-295 (hereinafter *Goldfarb and Prescod*). The

Manual of Patent Examining Procedure (M.P.E.P.) states that a claim is anticipated by a reference only if each and every element as set forth in the claim is found in the reference and, furthermore, that the identical invention must be shown in as complete detail as is contained in the claim.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. ... The **identical** invention must be shown in as complete detail as is contained in the ... claim.

(M.P.E.P. § 2131, emphasis added). Each of the independent claims 34 and 42-43 as amended herein includes at least one feature that is not found in *AFM97* or *Goldfarb and Prescod*. For at least this reason, the rejection under 35 U.S.C. § 102(b) of each independent claim 34 and 42-43 should be withdrawn.

For example, each of the independent claims 34 and 42-43 requires a user interface resource file that includes markup language with particular properties. The markup language includes resource tags. The tags may have attributes, the attributes may have values, and, in particular, the attributes may have default values. If the default value for an attribute is satisfactory, for example, to a designer, then the designer needn't specify the attribute value explicitly. The markup language is required to include multiple resource tag attribute default value mechanisms. Furthermore, the multiple mechanisms have an order corresponding to a precedence order for the default values.

At least one user interface resource file ... comprising ... markup language, wherein ... the markup language includes a plurality of resource tag attribute default value mechanisms whose order corresponds to a precedence order of default values for the attributes.

(Claim 34, as amended). Although *Goldfarb and Prescod* mentions XSL stylesheets, which may be construed as a resource tag attribute default value mechanism for the purposes of applying the reference to the claims, neither *Goldfarb and Prescod* nor *AFM97* describe a markup language having the properties required by independent claims 34 and 42-43 and therefore fail to teach each and every element of the claims in as complete detail as is contained in the claims for at least this reason.

Rejections Under 35 U.S.C. § 103 of the Independent Claims

Each of the independent claims 26 and 38 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *AFM97* and *Goldfarb and Prescod*. However, the M.P.E.P. states that, to support the rejection of a claim under 35 U.S.C. § 103(a), each feature of each rejected claim must be taught or suggested by the applied prior art, and that each of the words describing the feature must be taken into account.

To establish *prima facie* obviousness of a claimed invention, **all** the claim limitations **must** be taught or suggested by the prior art. ... **All** words in a claim **must** be considered in judging the patentability of that claim against the prior art.

(M.P.E.P. § 2143.03, emphasis added). Each of the independent claims 26 and 38 as amended herein includes at least one feature not taught or suggested by *AFM97* or *Goldfarb and Prescod*, alone or in combination, and is therefore patentable for at least this reason.

In particular, as described above for independent claims 34 and 42-43, each of the independent claims 26 and 38 is amended herein to further clarify the nature of a markup language in embodiments of the invention. However, not only does *AFM97* or *Goldfarb and Prescod* fail to teach each and every element of the claims in as complete detail as is contained in the claims, neither *AFM97* nor *Goldfarb and Prescod*, nor any of the prior art of record, alone or in combination, teaches or fairly suggests a markup language having the claimed properties. The rejection under 35 U.S.C. § 103(a) of independent claims 26 and 38 should therefore be withdrawn for at least this reason. Furthermore, for at least the same reason, a new rejection of independent claims 34 and 42-43 under 35 U.S.C. § 103(a) based on a combination of teachings including those of *AFM97* or *Goldfarb and Prescod* would be inappropriate.

The Remaining Dependent Claims

Each of claims 26, 34, 38 and 42-43 is in independent form, whereas all of the remaining claims depend directly or indirectly on one of these five independent claims. The dependent claims are allowable for at least the same reasons that the five independent claims 26, 34, 38 and 42-43 are allowable in that the dependent claims incorporate the features of the independent claims. Nevertheless, the dependent claims further define subject matter not shown or rendered obvious by the prior art of record. Because the independent claims are

allowable over the applied prior art, applicants do not believe remarks addressing this further subject matter are necessary herein.

Newly Added Claims

Claims 47-53 have been added in this amendment to more particularly point out and distinctly claim the invention as described by the specification. In compliance with 37 C.F.R. § 1.121(f), they do not add new matter.

Information Disclosure Statement Filed September 7, 2004

The Office action states that the information disclosure statement filed September 7, 2004 failed to comply with 37 C.F.R. § 1.98(a)(2) because some copies of listed references were not supplied. However, the return postcard for the filing indicates that all copies of listed references were, in fact, received by the U.S.P.T.O. As a courtesy, copies of the information disclosure statement, the unconsidered references and the return postcard are enclosed herewith. The Examiner is respectfully requested to consider the references and appropriately initial the Form PTO-1449.

CONCLUSION

The application is considered in good and proper form for allowance, and the examiner is respectfully requested to pass this application to issue. If, in the opinion of the examiner, a telephone conference would expedite the prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,


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Date: February 7, 2005